



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/399,304	09/17/1999	STEPHEN CLIFFORD GOSS	CASE-4	2132

7590

08/12/2005

REGINALD J. HILL
JENNER & BLOCK LLP
ONE IBM PLAZA
CHICAGO, IL 60611

EXAMINER

LEE, JOHN J

ART UNIT	PAPER NUMBER
----------	--------------

2684

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>09/399,304</p>	<p>Applicant(s)</p> <p>GOSS, STEPHEN CLIFFORD</p>	
	<p>Examiner</p> <p>JOHN J. LEE</p>	<p>Art Unit</p> <p>2684</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-12, 14-25, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 13 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Applicant's arguments with respect to claims 1 - 28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-4, 7-12, 14-17, 20, 21, 23-25, 27 and 28** are rejected under 35 U.S.C. 102(e) as being anticipated by Yang et al. (US Patent number 6,088,577).

Regarding **claim 1**, Yang discloses that a method for use in a wireless network (Fig. 2 and column 5, lines 63 – column 6, lines 38). Yang discloses that wireless network comprising a plurality of base stations, each serving a plurality of users via a plurality of communication channels (Fig. 2, 3 and column 5, lines 63 – column 6, lines 38). Yang teaches that transmitting an alert message (transmitting a alert signal, message, to remote users) from a set of said base stations, to a plurality of users, (a system transmits alert message to remote users), said alert message including the identity of one of said plurality of communication channels, said alert message including to said plurality

of users that a broadcast message is available (Fig. 2, 3, column 3, lines 50 – column 4, lines 60, and column 7, lines 12 – 33, where teaches a system which digitizes and compresses an analog voice signal, for subsequent transmission through an FM broadcast SCA channel. Prior to message transmission, a user identification code is transmitted through an FM broadcast channel to alert a specifically identified pager that a message is being sent and then the actual message is transmitted at high speed via the SCA channel to the pager). Yang teaches that transmitting a broadcast message from said set of base stations to said plurality of users on said one of said plurality of communications channels (Fig. 2, 3, column 3, lines 50 – column 4, lines 60, and column 7, lines 12 – 33, where teaches the broadcast message, that a message is being sent, is transmitted from the base station to users on the communication channels).

Regarding **claim 2**, Yang teaches that the wireless network also includes a control channel (broadcast channel), wherein said step of transmitting said alert message comprises transmitting said alert message on said control channel (Fig. 2, 3, column 3, lines 50 – column 4, lines 60, and column 7, lines 12 – 33, where teaches the alert message, awaken message, on the broadcast channel, control channel).

Regarding **claim 3**, Yang teaches that the step of transmitting an alert message further comprises the step of transmitting a permission parameter as a part of said alert message (Fig. 2, 3 and column 5, lines 26 – column 6, lines 38, where teaches the subscriber authorization feature for each channel is subdivided into first and second subchannels by the use of subscriber authorization frequencies (frequencies permit paging functions)).

Regarding **claim 4**, Yang teaches that the step of transmitting said alert message further comprises repeatedly transmitting an alert message on a periodic basis while said broadcast message is transmitted (Fig. 2, 3, column 1, lines 65 – column 2, lines 8, and column 3, lines 50 – column 4, lines 60).

Regarding **claim 7**, Yang teaches that the one of said plurality of communication channels (a broadcast channel) is selected from a reserved group of said plurality of communication channels (SCA broadcast communication channels) (Fig. 2, 3 and column 5, lines 26 – column 6, lines 61).

Regarding **claim 8**, Yang teaches that the one of said plurality of communication channels is selected from a list of idle ones (available channels) of said plurality of communication channels (column 3, lines 50 – column 4, lines 67 and Fig. 2, 3).

Regarding **claim 9**, Yang teaches that the alert message includes the identity of said one of said plurality of communication channels such that each of said plurality of base stations selects the same one of said plurality of communication channels (column 3, lines 50 – column 4, lines 67 and Fig. 2, 3, where teaches each base station selects FM broadcast SCA channel for notification (alerting)).

Regarding **claim 10**, Yang teaches that each of said plurality of base stations selects one of said plurality of communication channels based on channel availability, wherein said one of said plurality of communication channels may be different between each of said base stations (column 3, lines 50 – column 4, lines 67 and Fig. 2, 3, where teaches each base station selects a FM broadcast SCA channel for notification (alerting)).

and also can select RDS channel optionally if the FM broadcast SCA channel is not available).

Regarding **claim 11**, Yang teaches that the broadcast message originates at an information source remote from said base stations (Fig. 2, 3, column 3, lines 50 – column 4, lines 60, and column 7, lines 12 – 33).

Regarding **claim 12**, Yang teaches all the limitation as discussed in claim 1. Furthermore, Yang further discloses that means for receiving a first alerting message indicating that a broadcast message is imminent (notification for actual message is being sent), and indicating the communication channel of said broadcast message (Fig. 2, 3, column 3, lines 50 – column 4, lines 60, and column 7, lines 12 – 33, where teaches the base system transmits a message through the FM broadcast channel to alert a specifically identified pager that a message is being sent). Yang teaches that means for alerting a user of said wireless unit that said broadcast message is imminent (Fig. 2, 3, column 3, lines 50 – column 4, lines 60, and column 7, lines 12 – 33, where teaches the base system transmits to the remote users a message through the FM broadcast channel to alert a specifically identified pager that a message is being sent).

Regarding **claim 14**, Yang teaches that for selecting whether to receive said broadcast message (column 3, lines 9 – column 4, lines 33 and Fig. 2, 3).

Regarding **claim 15**, Yang discloses that wireless unit uses CDMA protocol, wherein said communication channel is extracted using a corresponding one of a plurality of Walsh functions (column 5, lines 24 – column 6, lines 61 and Fig. 1, 2, this is well

Art Unit: 2684

known art using Walsh function (code) in the CDMA protocol in the cellular communication).

Regarding **claim 16**, Yang discloses that the wireless unit uses an analog air interface protocol, wherein said communication channel is extracted using an FM receiver tuned to a corresponding frequency (Fig. 2, 3, column 3, lines 50 – column 5, lines 6, and column 7, lines 12 – 33).

Regarding **claim 17**, Yang discloses that the wireless unit uses a TDMA protocol, wherein said communication channel is extracted using a receiver tuned to a corresponding frequency and selecting appropriate time slots of a received TDM data stream (column 5, lines 24 – column 6, lines 61 and Fig. 1, 2, this is well known art using time slots of received TDM data stream in the TDMA protocol in the cellular communication).

Regarding **claim 20**, Yang discloses that the wireless unit includes a keypad, wherein said user means for selecting comprises entering one or more digits on said keypad (column 5, lines 24 – column 6, lines 61 and Fig. 2, 3).

Regarding **claim 21**, Yang discloses that the wireless unit includes a keypad, wherein said user means for selecting comprises a button separate from said keypad (column 5, lines 24 – column 6, lines 61 and Fig. 2, 3).

Regarding **claim 23**, Yang discloses that the communication channel comprises a forward link and a reverse link, and said wireless unit includes means for blocking automatically said reverse link of said communication channel for the duration of said broadcast message (column 5, lines 24 – column 6, lines 61 and Fig. 2, 3, where teaches

Art Unit: 2684

inherently, automatically blocking reverse link (transmitting remote unit to base station) when the remote unit receives the broadcast message).

Regarding **claim 24**, Yang discloses all the limitation, as discussed in claims 1 and 12.

Regarding **claim 25**, Yang discloses all the limitation, as discussed in claims 1 and 2.

Regarding **claim 27**, Yang discloses all the limitation, as discussed in claims 1 and 12. Furthermore, Yang further teaches receiving a call placed by one of said plurality of users in accord with said dialing instruction (column 5, lines 24 – column 6, lines 61 and Fig. 2, 3).

Regarding **claim 28**, Yang discloses all the limitation, as discussed in claims 12 and 23.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 18, 19, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Dorenbosch (US Patent number 5,959,546).

Regarding **claims 18 and 19**, Yang does not specifically disclose the limitation “alerting comprises a user-visible signal and user-audible signal”. However, Dorenbosch

discloses the limitation “alerting comprises a user-visible signal and user-audible signal” (column 5, lines 12 – column 6, lines 5 and Fig. 4, 5, where teaches notifying can include either a display such a liquid crystal display or a tactile or audible alert). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Yang system as taught by Dorenbosch. The motivation does so would be to provide efficient mobile notification service for users in mobile communication system.

Regarding **claim 22**, Yang and Dorenbosch disclose the all the limitation, as discussed in claims 1 and 19.

Allowable Subject Matter

6. Claims 5, 6, 13, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to disclose “the set of base stations complete transmission of said broadcast message, said set of base stations sending a further alert message to inform the users that said one of said plurality of communication channels will expire in a predetermined time, and receiving a second alerting message indicating that said broadcast message is over and for automatically restoring said wireless unit to said stored state upon receipt of said second alerting message” as specified in the claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Olds et al. (US Patent number 5,930,679) discloses Satellite-Based Ring Alert Apparatus and Method of Use.

Raith et al. (US Patent number 6,073,005) discloses Identifying Emergency Calls in Radio communication Systems.

Information regarding...Patent Application Information Retrieval (PAIR) system... at 866-217-9197 (toll-free)."

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
Or P.O. Box 1450
Alexandria VA 22313

or faxed (571) 273-8300, (for formal communications intended for entry)

Or: (703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to USPTO Headquarters, Alexandria, VA.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(571) 272-7880**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Nay**

Art Unit: 2684

Aung Maung, can be reached on (571) 272-7882. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L
July 18, 2005

 8/5/05
TIKAHUN GESESSE
PRIMARY EXAMINER

John J Lee